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| 10/657,394      | 09/08/2003  | William J. Mertz     | 1248 P 122          | 9357             |

7590 01/27/2005

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| EXAMINER |
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KEEHAN, CHRISTOPHER M

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| ART UNIT | PAPER NUMBER |
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1712

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/657,394

**Applicant(s)**

MERTZ ET AL.

**Examiner**

Christopher M. Keehan

**Art Unit**

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/9/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kerr et al. (WO 98/28376).

Regarding claims 1-3, Kerr et al. disclose a release liner comprising a substrate having opposing surfaces, and a radiation cured silicone release coating in an organic solvent, absent a crosslinkable silicone hydride resin on a surface thereof (pages 17 and 18, Comparative Example 1), the coating comprising amounts of less than 5.0% occurring (page 17, lines 8-13). Although Kerr et al. do not appear to specifically disclose no more than about 1.5 micrograms per square centimeter of total extractables, this appears to be inherently disclosed because the same silicone composition (applicant's

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specification, page 6, lines 3-7), and curing temperature (applicant's Examples) as disclosed by applicant are disclosed by Kerr et al. in a working example (pages 17 and 18, Comparative Example 1) and curing temperature (page 15, lines 25-28), and the same materials and process step would have inherently yielded the same properties. Similar processes can reasonably be expected to yield products which inherently have the same properties. *In re Spada* 15 USPQ 2d 1655 (CAFC 1990); *In re DeBlauwe* 222 USPQ 191; *In re Wiegand* 86 USPQ 155 (CCPA 195). If not inherently disclosed, then it would have been obvious to one of ordinary skill in the art at the time the invention was made for the composition of Kerr et al. to have achieved at least a similar amount of extractables because the materials and curing temperature of Kerr et al. are at least similar to those of Applicant, and at least similar materials would have yielded at least similar inherent properties.

Regarding claims 4 and 5, Kerr et al. disclose that the composition can be solvent free (page 16, lines 1-5), which would appear to yield a volatile-free coating. Further, because the coating of Kerr et al. is the same as disclosed by applicant, this appears to be inherently disclosed (as set forth above).

Regarding claim 6, Kerr et al. do not appear to specifically disclose substantially no transfer of uncured silicone to adjacent surfaces. However, because the materials and curing temperature of Kerr et al. are the same as applicant's, it appears that this is an inherent property because the same materials and curing temperature would have inherently yielded a coating with the same inherent properties. Similar processes can reasonably be expected to yield products which inherently have the same properties. *In*

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*re Spada* 15 USPQ 2d 1655 (CAFC 1990); *In re DeBlauwe* 222 USPQ 191; *In re Wiegand* 86 USPQ 155 (CCPA 195). If not inherently disclosed, then it would have been obvious to one of ordinary skill in the art at the time the invention was made for the coating of Kerr et al. to have achieved at least substantially no transfer of uncured silicone to adjacent surfaces because the materials and curing temperature of Kerr et al. are at least similar to those of applicant, and at least similar materials would have yielded at least similar inherent properties.

Regarding claims 7 and 8, Kerr et al. disclose a second release coating, with the coating of Kerr et al. being placed on another surface (page 16, lines 17-23).

Regarding claims 9-11, Kerr et al. disclose the instantly claimed substrates (page 22, lines 7-11).

Claims 1-6 and 9-11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Leir et al. (5,753,346).

Regarding claims 1-3, Leir et al. disclose a release liner comprising a substrate having opposing surfaces, and a radiation cured silicone release coating in an organic solvent, absent a crosslinkable silicone hydride resin on a surface thereof (col.12, Examples 1-28). Although Leir et al. do not appear to specifically disclose no more than about 1.5 micrograms per square centimeter of total extractables, this appears to be inherently disclosed because the same silicone composition as claimed by applicant, and curing temperature (applicant's Examples) as disclosed by applicant are disclosed by Leir et al. in a working example (pages 17 and 18, Comparative Example 1) and the same

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materials and process step would have inherently yielded the same properties. Similar processes can reasonably be expected to yield products which inherently have the same properties. *In re Spada* 15 USPQ 2d 1655 (CAFC 1990); *In re DeBlauwe* 222 USPQ 191; *In re Wiegand* 86 USPQ 155 (CCPA 195). If not inherently disclosed, then it would have been obvious to one of ordinary skill in the art at the time the invention was made for the composition of Leir et al. to have achieved at least a similar amount of extractables because the materials and curing temperature of Leir et al. are at least similar to those of applicant, and at least similar materials would have yielded at least similar inherent properties.

Regarding claims 4 and 5, Leir et al. disclose that the solvent is evaporated from the coating (col.12, Examples 1-28), which would appear to yield a volatile-free coating. Further, because the coating of Leir et al. is the same as claimed by applicant, this appears to be inherently disclosed (as set forth above).

Regarding claim 6, Leir et al. do not appear to specifically disclose substantially no transfer of uncured silicone to adjacent surfaces. However, because the materials and curing temperature of Leir et al. are the same as that claimed by applicant, it appears that this is an inherent property because the same materials and curing temperature would have inherently yielded a coating with the same inherent properties. Similar processes can reasonably be expected to yield products which inherently have the same properties. *In re Spada* 15 USPQ 2d 1655 (CAFC 1990); *In re DeBlauwe* 222 USPQ 191; *In re Wiegand* 86 USPQ 155 (CCPA 195). If not inherently disclosed, then it would have been obvious to one of ordinary skill in the art at the time the invention

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was made for the coating of Leir et al. to have achieved at least substantially no transfer of uncured silicone to adjacent surfaces because the materials and curing temperature of Leir et al. are at least similar to those of applicant, and at least similar materials would have yielded at least similar inherent properties.

Regarding claims 9-11, Leir et al. disclose the instantly claimed substrates (col.9, line 54-col.10, line 20).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leir et al. (5,753,346). Leir et al., as applied above, are as set forth and incorporated herein. Leir et al. do not appear to specifically disclose a second release coating on the opposite side of the substrate. However, the repetition of steps to provide the same results is within the skill of one having ordinary skill in the art. The concept of duplication is not patentable. *St. Regis Paper Co. v. Bemis Co. Inc.*, 193 USPQ 8, 11 (7th Cir. 1977). While this decision relates to the duplication of parts, there is no reason why such duplication cannot be extended to a process step.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (571) 272-1087. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Keehan

January 18, 2005

*C. Keehan*  
DAVID J. BUTTNER  
PRIMARY EXAMINER

*David Buttner*